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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,242	04/24/2001	Soren Vindriis	CU-2508RJS	3307

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EXAMINER

ARNOLD III, TROY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/830,242

Applicant(s) *MF*

VINDRIIS, SOREN

Examiner

Troy Arnold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 21 January 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the fabric extending between the foils, as in claims 1 and 6 and the amendment to the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fabric being between the foils must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 1 (line 8) and 6, Applicant claims the fabric "extending between the foils." At several points in the specification, and in the drawings, Applicant discloses the fabric on an outer side of the foils, or partially enclosed in the foil, from the outer side. There is however, no enabling disclosure for the fabric extending between the foils. Page 4, line 4 does not provide enabling disclosure. The newly amended section of the specification simply states this condition with no explanation of how to make or use it. Further, the method claimed in claim 6 could not be used to put the fabric between the foils.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 (line 8) and claim 6, Applicant claims the fabric is "extending between the foils." This phrase is vague and indefinite. Where exactly is the fabric in relation the foil(s)? The drawings show the fabric outside the foils,

the specification discloses the fabric outside the foils, or partially embedded in the foils, from the outside.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutcheson in view of Ogden. Hutcheson teaches all the limitations of claim 1 except the fabric being partially enclosed in the foil. (See the embodiment in Fig 11, described in column 5, beginning line 18). Ogden teaches an insole construction in which a portion 46 of a non-woven fabric layer 22 is coated or covered with a liquid barrier layer, which then cools to become solid. See column 12 lines 66-67 and column 13, lines 1-15. Although the molten barrier layer 62 does not penetrate all the way through the non-woven layer 22B, some portion of it, 46, will be coated with the barrier layer 62, which means that it will be partially enclosed in it. Further, in column 13 line 3, Ogden discusses "heat bonding" which implies at least the partial enclosure of one layer in the other, given the relative softness, required thickness and low melting point of the materials used. It would have been obvious in view of Ogden to one of ordinary skill in the art at the time the invention was made to partially enclose the fabric layers 56 and 58 in the foil layers 12 and 14 of Hutcheson, by melting, for the purpose of ensuring that

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they are better retained against relative movement. Regarding claim 2, one or more of the materials specified for the outer coverings 56,58 of the invention of Hutcheson will have a coefficient of friction ratio as claimed. See also the Abstract and Specification where the coefficient of friction of the top layer may be varied to suit different applications. Regarding claim 3, Hutcheson teaches the top plastic layer covered with fabric such as cotton or synthetic material. As regarding claim 2, a variety of coefficients of friction will be covered by the material specified by Hutcheson in column 5, lines 23-28, thus satisfying the limitations of the claim. Hutcheson teaches all the limitations of claim 4 except the fabric having a higher tensile strength than the top plastic layer. In view of the various materials suggested by Hutcheson in column 5, lines 43-48, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tensile strength of the fabric material higher than that of the plastic layer for the purpose of ensuring that the fabric adequately protected the plastic layer against rupture. This is clearly well within the capability of one of ordinary skill in the art. Hutcheson teaches all the limitations of claim 5 except the top fabric layer being impregnated with fungicide. Ogden teaches a barrier layer being impregnated with antimicrobial material with fungistatic properties. It would have been obvious in view of Ogden to one of ordinary skill in the art at the time the invention was made to incorporate fungicide into the top material layer of Hutcheson for the purpose of improving the sanitary environment of the foot. See also Hutcheson, column 5, lines 33-37 where he discusses additive substances. Regarding claim 6, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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assemble the insole of Hutcheson as modified above, in the manner claimed. There is nothing unobvious about the procedure claimed; in fact it may be the *only* way Hutchesons' modified insole could be made.

Response to Arguments

Applicant's arguments have been carefully considered but are not persuasive. Regardless of the potential uses or problems solved by the Applicant's invention, it is maintained that Hutcheson as modified by Ogden teaches all of the limitations in the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621.

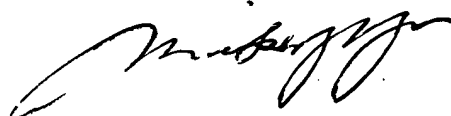
The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-0302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold
Examiner
Art Unit 3728

TGA
April 10, 2003



Mickey Yu
Supervisory Patent Examiner
Group 3700